

RECEIVED  
CENTRAL FAX CENTER

OCT 21 2004

Docket No. 740105-78

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: )  
Gerd M. MÜLLER et al. )  
Serial No. 09/938,533 ) Group Art Unit: 3736  
Filed: August 27, 2001 ) Examiner: J.M. Foreman  
For AT LEAST PARTIALLY ) Confirmation No. 2799  
IMPLANTABLE HEARING )  
SYSTEM )

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office: Fax No. (703) 872-9306 on October 21, 2004.

  
Kathleen M. McManus

**REQUEST FOR WITHDRAWAL OF PREMATURE FINAL REJECTION**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

On October 1, 2004, an Office Action was mailed in connection with the above-identified application which the Examiner made final citing MPEP § 706.07(b).

However, the very section cited by the Examiner makes it clearly that the Examiner could not properly make the October 1<sup>st</sup> Office Action final because

it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

In this case, the Examiner issued an Advisory Action on July 14, 2004, which refused entry of Applicants' response because it raised new issues that would require further consideration and/or response. Thus, in accordance with the requirements of MPEP § 706.07(b), the first action in this RCE case could not properly be finally rejected based on the prohibition quoted above from MPEP § 706.07(b).

Docket No. 740105-78  
Serial No. 09/938,533  
Page 2

Accordingly, applicants are entitled to have a response to the rejections contained in the October 1<sup>st</sup> Office Action considered as a matter of right, not under the limitations imposed with respect to finally rejected claims. Therefore, it is requested that the Examiner issue a Supplemental Office Action withdrawing the finally rejected status imposed by his October 1, 2004, Office Action, and that such be done promptly so that applicants will know under what conditions a response is being filed.

Respectfully submitted,



David S. Safran  
Registration No. 27,997

NIXON PEABODY LLP  
Suite 900  
401 9<sup>th</sup> Street, N.W.  
Washington D.C. 2004

Telephone: (703) 827-8094

DSS:kmm